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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/816,782	04/02/2004	Sang-Ki Nam		9964

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05/24/2005

SANG-KI NAM
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KOREA, REPUBLIC OF

EXAMINER

BLAU, STEPHEN LUTHER

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 05/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

10/816,782

Applicant(s)

NAM, SANG-KI

Examiner

Stephen L. Blau

Art Unit

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☒ Claim(s) 6,8 and 9 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 7/1/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

1. The abstract of the disclosure is objected to because it is greater than one paragraph. Correction is required. See MPEP § 608.01(b).

Claim Objections

2. Claims 6, 8, and 9 objected to because of the following informalities: Each of these claims contain two occurrences of the word "a" after the word "includes". One of the words needs to be deleted and in claim 6 and 9 the "a" needs to be changed to --an--. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The statement "the coating film layer is formed, on its surface, with a number of fine projections by pressing correspondingly the surface of the coating

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film” does not make sense. From figure 5 and the specification it seems that these fine projections are formed and is not formed by pressing the surface. It is uncertain what pressing the surface produces.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1 and 2 are rejected under 35 U.S.C. 102(e) as being anticipated by Novak.

Novak discloses a sheet layer (32) of an elastomeric material covering part of the shaft [0022], a transparent layer [0020], a cavity (34), and a coating film layer in the form of a lamination [0023].

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 4 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Novak in view of Skerker and Jacob.

Novak lacks a grip transparent shell being made of EPDM made of a mixture of ethylene, propylene and non-conjugated diene. Skerker discloses a translucent handle (Claim 2) for a golf club (Col. 1, Lns. 12-20) where the handle material is made of an elastomer of EPDM (ethylene-propylene terpolymers) (Col. 3, Lns. 11-17). In view of the patent of Skerker it would have been obvious to modify the grip of Novak to have a material of EPDM in order to utilize other transparent materials used in the market place for grip material. Jacob discloses a TPE material used for grips [0030] where the TPE is a EPDM having a non-conjugated diene [0011] in order to have improved bonding to polar substrates and increased hardness not previously achievable [0007]. In view of the publication of Jacob it would have been obvious to modify the grip of Novak to have a TPE being EPDM having a non-conjugated diene in order to have improved bonding to polar substrates and increased hardness not previously achievable and in order to utilize an EPDM used in the market place for golf grips.

9. Claims 5 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Novak in view of Skerker and Jacob as applied to claims 4 and 7 above, and further in view of Griffin.

Novak lacks a transparent shell having a perfume. Griffin discloses a perfume (Col. 4, Lns. 18-20) added to a synthetic elastomer used for an exercise device which a user manipulates with the hand (Col. 1, Lns. 32-58). In view of the patent of Griffin it would have been obvious to modify the grip of Novak to have an elastomer which includes a perfume in order to make the grip to have a pleasing smell to a user.

10. Claims 6 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Novak in view of Skerker, Jacob, and Griffin as applied to claim 5 above, and further in view of Huang and 2003-0049007.

Novak lacks a transparent shell including an antibiotic nano material. Huang discloses placing an inorganic antimicrobial agent in an elastomer [0009] with silver being the agent [0014] in order to prevent health problems and contribute to the transmission of infectious agents [0005]. 2003-0049007 discloses an antimicrobial silver agent placed in plastic articles with the silver being nano-sized (DERWENT ABSTRACT). In view of the reference of Huang it would have been obvious to modify the grip of Novak to have a transparent shell including an antibiotic in order to prevent health problems and contribute to the transmission of infectious agents. In view of the references of 2003-0049007 it would have been obvious to modify the grip of Novak to have antibiotic material being nano in size in order to utilize a size used in the art of applying antimicrobial agents to composite material.

Allowable Subject Matter

11. Claim 3 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims. With respect to claim 3, none of the prior art discloses or renders as obvious a coating film layer between a sheet layer and a transparent shell with formed on its surface a number of fine projections in addition to the other elements of structure claimed.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steve Blau whose telephone number is (571) 272-4406. The examiner is available Monday through Friday from 8 a.m. to 4:30 p.m.. If the examiner is unavailable you can contact his supervisor Greg Vidovich whose telephone number is (571) 272-4415. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0858. (TC 3700 Official Fax 703-872-9306)

slb/ 19 May 2005


STEPHEN BLAU
PRIMARY EXAMINER